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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,721	04/09/2004	Robert Edwin Schneider	45568-00457	1511
25231	7590	10/05/2006		
MARSH, FISCHMANN & BREYFOGLE LLP 3151 SOUTH VAUGHN WAY SUITE 411 AURORA, CO 80014			EXAMINER GILBERT, SAMUEL G	
			ART UNIT 3735	PAPER NUMBER

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/821,721

Applicant(s)

ROBERT EDWIN SCHNEIDER

Examiner

Samuel G. Gilbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22, 24-26, 28-33 and 38 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-10, 12-20, 23, 27, 35 and 37 is/are rejected.
- 7) ☒ Claim(s) 6, 11, 21, 34, 36, 39 and 40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/11/2006 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 23 - the dependency of claim 23 is indefinite. For the purposes of action on the merits the dependency of claim 23 has been considered to be Claim 22.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7-10, 12-20, 35 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Metzler et al(5,702,342).

Claim 1 – element –24- is a retaining member, tongue –30- provides a guide which is movable along split –28-, the examiner is taking the position of element –24- against shoulder –26- as the locked position and any position other than that as the unlocked position, a spherical resilient member –54- and element –52- is the rotatable member. It is the examiners position that the member –52- is rotatable in two ways, first it is rotatable about the axis of the shaft and it is rotatable about a point centered in the spherical resilient element –54-. The angular movement is only limited by the post –48- and the opening in retention member –24-. In operation the resilient member is compressed between element –40- and element –24- by rotation of lock ring –41- as the resilient member is pressed between elements –40- and –24- the elongated opening –60- starts to close making channel –58- smaller. When channel –58- reduces in diameter the resilient member contacts a portion of post –52- at that point the resilient member is compressed between the two washers –24- and –40- and the post –52- therefore the resilient member is compressed between the rotatable member and the retention member. Further the claim includes “compressive spring force” and the applicant argues that Metzler et al does not teach a compressive spring force. The applicant has not set forth any special definition for “compressive spring force” therefore the examiner considers “compressive spring force” to be a broad term. It is the examiner's position that the resilient member –54- applies a compressive force to lock

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post -52- because as set forth above the resilient member is compressed between the post -52- and washer -40-. Further, the examiner believes the force is a spring force because upon loosening locking ring -41- the resilient member will resiliently expand or "spring" back to its original shape, therefore making the force applied a "spring force".

Claim 2 – tongues -30- and -42- are diametrically opposed around retention member -54-.

Claim 3 – when assembled retaining member -41- and resilient member -54- are interconnected as a single unit.

Claim 4 – the apparatus is receivable in a cavity in the mounting apparatus -12-.

Claim 5 – element -52- is a rotatable member (rotatable around the axis of the longitudinal axis of element -52- and also angularly rotatable with respect to a point inside the mounting apparatus). When locking ring -41- (rotatable member) is in the locked position, threaded into the mounting apparatus the frictional retention member will provide a limited amount of retention force/friction. It is the examiner's position that there would inherently be a predetermined amount of force required to rotate post -52- when the apparatus is in a locked position.

Claim 7 – elements -64- provides a first interface.

Claim 8 – rotatable member -52- supports hearing aid transducer -62-.

Claim 9 – the examiner is taking the mounting post -52- as a portion of the housing of the transducer -62-.

Claim 10 – element -26- is a bas distal element -24-.

Claim 12 – element –12- is a mounting apparatus, the examiner is taking elements –41- and –54- as retention apparatus. Element –41- moves along the threaded path to compress resilient member –54- to capture rotatable member –52-. In operation the resilient member is compressed between element –40- and element –24- by rotation of lock ring –41- as the resilient member is pressed between elements –40- and –24- the elongated opening –60- starts to close making channel –58- smaller. When channel –58- reduces in diameter the resilient member contacts a portion of post –52- at that point the resilient member is compressed between the two washers –24- and –40- and the post –52- therefore the resilient member is compressed between the rotatable member and the retention member. Further the claim includes “compressive spring force” and the applicant argues that Metzler et al does not teach a compressive spring force. The applicant has not set forth any special definition for “compressive spring force” therefore the examiner considers “compressive spring force” to be a broad term. It is the examiner’s position that the resilient member –54- applies a compressive force to lock post –52- because as set forth above the resilient member is compressed between the post –52- and washer –40-. Further, the examiner believes the force is a spring force because upon loosening locking ring –41- the resilient member will resiliently expand or “spring” back to its original shape, therefore making the force applied a “spring force”.

Claim 13 – element –41- is a retaining member, slots –64- provide a pair of guides and washer –40- provides a base distal the retaining member.

Claim 14 – it is the examiner's position that a tool such as a screwdriver would inherently be used to interface with retention member –41- and slots –64-

Claim 15 – the examiner is taking the un-numbered opening at the intersection of slots –64- as a first interface.

Claim 16 – the second interface is shown by lead line –40- in figure 1.

Claim 17 - rotatable member –52- supports hearing aid transducer –62-.

Claim 18 - the examiner is taking the mounting post –52- as a portion of the housing of the transducer –62-.

Claim 19 – it is the examiner's position that the device is capable of being preassembled prior to implantation.

Claim 20 – the examiner is taking tongues –30- and –42- as detents engageable with channel –28-.

Claim 35 – the resilient member –54- is inherently compressible in a direction traverse to said retaining member.

Claim 37 – the resilient member –54- is inherently compressible in a direction traverse to said retaining member.

### ***Response to Arguments***

Applicant's arguments filed 8/11/2006 have been fully considered but they are not persuasive.

The applicant argues that Metzler et al does not teach a device wherein the resilient member applies a compressive spring force on the rotating member. In response the examiner takes the following position.

In operation the resilient member is compressed between element -40- and element -24- by rotation of lock ring -41- as the resilient member is pressed between elements -40- and -24- the elongated opening -60- starts to close making channel -58- smaller. When channel -58- reduces in diameter the resilient member contacts a portion of post -52- at that point the resilient member is compressed between the two washers -24- and -40- and the post -52- therefore the resilient member is compressed between the rotatable member and the retention member. Further the claim includes "compressive spring force" and the applicant argues that Metzler et al does not teach a compressive spring force. The applicant has not set forth any special definition for "compressive spring force" therefore the examiner considers "compressive spring force" to be a broad term and not requiring any particular structure. It is the examiner's position that the resilient member -54- applies a compressive force to lock post -52- because as set forth above the resilient member is compressed between the post -52- and washer -40-. Further, the examiner believes the force is a spring force because upon loosening locking ring -41- the resilient member will resiliently expand or "spring" back to its original shape, therefore making the force applied a "spring force".

The applicant further describes the arrangement of Metzler et al and indicates that "any activated force within the friction retention member -54- will be directed away



from the mounting post. The examiner would like to point out that the claims do not include a recitation of any "activated force". Further the applicant describes the connection between elements -54- and -52- as a frictional connection. The examiner believes that the friction is created by the compression of element -54- as claimed.

***Allowable Subject Matter***

Claims 6, 11, 21, 34, 36, 39, and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 22, 24-26, 28-33 and 38 are allowed.

Claims 23 and 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

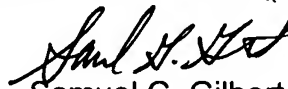
Claim 22 – the prior art does not teach or fairly suggest a method as claimed for implanting a hearing aid transducer including using a spring loaded retention apparatus to capture a rotatable member in a desired angular orientation.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Gilbert whose telephone number is 571-272-4725. The examiner can normally be reached on Monday-Friday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor II can be reached on 571-272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Samuel G. Gilbert  
Primary Examiner  
Art Unit 3735

sgg